

REMARKS

By this Amendment, Claims 1, 5, 7, 8 and 13 have been amended and Claim 16 has been deleted, without prejudice, to place this application in immediate condition for allowance.

In the outstanding Office Action, the Examiner has objected Claim 16 under 37 C.F.R. 1.75 as allegedly being a "substantial duplicate of claim 15." In this regard, Applicants respectfully disagree with this objection since the phrase "significant low frequency absorption" in Claim 16 is materially different than the recitation in Claim 15 of "measurable low frequency absorption." However, in order to expedite the prosecution of this application, Claim 16 has been deleted, without prejudice.

In the outstanding Office Action, the Examiner has rejected Claims 1-5, 7, 15 and 16 under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,193,318 to D'Antonio et al. In order to overcome this ground of rejection, independent Claim 1 has been amended to add recitation of a rear surface and to specify "means permitting sound waves to travel from said front surface to said rear surface through said body." This structure is nowhere taught or suggested by the D'Antonio et al. Patent. Therein, disclosure is made of slots, for example, the slots 32 and 52 that allow access to the respective chambers 30 and 50 within the body of the cinder blocks 20 and 40, respectively. D'Antonio et al. fail to teach or suggest a connection between the front surface and

rear surface of a diffusor through the body thereof. As such, these claims are believed free of anticipation from D'Antonio et al.

The Examiner has rejected Claims 6 and 19 under 35 U.S.C. 103(a) as allegedly being unpatentable over D'Antonio et al. as applied to Claim 1 and further in view of U.S. Patent No. 6,015,026 to McGrath. In making this ground of rejection, the Examiner has relied upon McGrath for the alleged teaching of a compound curved shape. Based upon the claims as amended herein, this ground of rejection is without basis and should be withdrawn. Claims 6 and 19 depend from independent Claim 1 which has been clearly demonstrated hereinabove to be free of anticipation from D'Antonio et al. McGrath fails to cure the deficiencies of D'Antonio et al. vis.a.vis these claims because McGrath fails to teach or suggest a diffusor in which there is means permitting sound waves to travel through the body thereof to a rear surface of that body. As such, Claims 6 and 19 are believed patentable.

In the outstanding Office Action, the Examiner has rejected Claims 8, 13 and 14 under 35 U.S.C. 103 as allegedly being unpatentable over D'Antonio et al. in view of U.S. Patent No. 5,422,446 to Fries. In making this ground of rejection, the Examiner has relied upon Fries for a teaching of a plurality of holes permitting connection between the front and rear of an absorber. Applicants must respectfully disagree with this ground

of rejection. D'Antonio et al. teach a diffuser having a body with an internal chamber connected to a front facing diffuser via slots. Fries teaches a panel solely disclosed as an absorber and including a plurality of holes connecting the front and rear surfaces thereof through its body. Fries neither teaches or suggests diffusion.

The Patent and Trademark Office has the initial burden of producing a factual basis for a rejection under 35 U.S.C. § 103. In other words, the Patent and Trademark Office must establish a prima-facie case for obviousness. If examination does not produce a prima-facie case of unpatentability under § 103, then without more, the applicant is entitled to a grant of the patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992). The issue of the prima-facie case for obviousness was recently visited by the Federal Circuit in *In re Thrift*, 63 USPQ 2d 2002. In that case, the Federal Circuit stated the following:

"To establish a prima-facie case of obviousness the Board must, *inter alia*, show 'some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.' *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988). 'The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.' *In re Kotzab*, 217 F.3d 1365, 1370, 15 USPQ 2d 1313, 1317 (Fed. Cir. 2000)."

63 USPQ 2d at 2006.

In the well known case, *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984), the Court addressed the issue of whether a case for prima-facie obviousness had been established. In that case, the Examiner sought to apply U.S. Patent No. 1,175,948 to French which discloses "a liquid strainer for removing dirt and water from gasoline and other like oils." 221 USPQ at 1127. In the French strainer, disclosure is made that the straining action relies "at least in part, upon the assistance of gravity to separate undesired dirt and water from gasoline and other like oils." *Id.* In attempting to apply the French patent against the claims on appeal, the Examiner proposed inverting the French strainer. The Federal Circuit concluded that such a ground of rejection failed to establish prima-facie obviousness. *Id.* The Court stated that:

"[T]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *Id.*

"Indeed, if the French apparatus were turned upside down, it would be rendered inoperable for its intended purpose. The gasoline to be filtered would be trapped in pocket 9, and the water French seeks to separate would flow freely out of the outlet 5. Further, unwanted dirt would build up in the space between the wall of shell 1 and screen 21, so that, in time, screen 21 would become clogged unless a drain valve, such as pet-cock 13, were re-introduced at the new 'bottom' of the apparatus. ... In effect, French teaches away from the Board's proposed modification. Because the PTO has failed to establish a prima-facie case of obviousness, the rejection of Claims 1-3 and 5-7 as unpatentable under 35 U.S.C. § 103 must be reversed." *Id.*

Thus, in *In re Gordon*, the Federal Circuit held that where the prior art applied against the claims on appeal, as applied, was rendered inoperable for its intended purpose, no prima-facie case for obviousness had been established.

If the Primary Examiner has established a case for prima-facie obviousness, the burden then shifts to the applicant to demonstrate why the claims are unobvious. See *Patents and the Federal Circuit*, 5th Edition, by Robert L. Harmon, § 4.7(b), page 185.

In *Graham v. John Deere Co.*, 383 US 1, 148 USPQ 459 (1966), the U.S. Supreme Court announced the test that has since become the standard guideline for assessing patentability under 35 U.S.C. §103. Under that section of the Patent Statutes, the Supreme Court stated that the inquiry was as follows:

"The scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined."

383 US at 17.

The inquiry as to when the issue of obviousness is to be resolved is that the inquiry is conducted "at the time the invention was made." 35 U.S.C. § 103(a). In attempting to reject claims under 35 U.S.C. § 103, there must be a reason or suggestion in the art for making the combination of features suggested by the Examiner other than knowledge learned from applicant's own

disclosure. *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ 2d 1529, 1532 (Fed. Cir. 1988). The test to be applied is whether the references taken as a whole would suggest the invention to one of ordinary skill in the art. *Medtronic Inc. v. Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1582, 220 USPQ 97, 110 (Fed. Cir. 1983). Focusing on the obviousness of substitutions and differences, instead of on the invention as a whole, is a legally improper way to simplify the often difficult determination of obviousness. *Gillette Company v. S.C. Johnson & Son, Inc.*, 16 USPQ 2d 1923, 1927 (Fed. Cir. 1990). A determination of obviousness must involve more than indiscriminately combining prior art; a motivation or suggestion to combine must exist. *Micro Chemical, Inc. v. Great Plains Chemical Company*, 41 USPQ 2d 1238, 1244 (Fed. Cir. 1997). Inherent in the forbiddance of the use of hindsight is the forbiddance of picking and choosing various features of different prior art references as a mosaic to recreate a facsimile of the claimed invention without a suggestion to combine them together in the references taken as a whole. *Akzo N.V. v. United States ITC*, 808 F.2d 1471, 1481, 1 USPQ 2d 1241, 1246 (Fed. Cir. 1986). Where the Examiner has picked and chosen various features from separate prior art references and has combined them together using applicant's own disclosure as the blueprint to do so, such a rejection is fatally flawed and must be reversed. *Heidelberger Druckmaschinenag v. Hantscho Commercial Products, Inc.*, 21 F.3d

1068, 1072, 30 USPQ 2d 1377, 1379-80 (Fed. Cir. 1994); *In re Geiger*, 815 F.2d 686, 688, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). It is improper to use the inventor's patent application as an instruction book on how to reconstruct the prior art. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1574, 1 USPQ 2d 1593, 1602 fn29 (Fed. Cir. 1987).

It is a tenet of patent law that an invention that otherwise might be viewed as an obvious modification of the prior art will not be deemed obvious in a patent law sense when one or more prior art references "teach away" from the invention. *Chisum on Patents*, § 5.03[3][a][i][G].

In *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 310 (Fed. Cir. 1983), the Federal Circuit found that the District Court had erred "in considering the references in less than their entirety, i.e., in disregarding disclosures in the references that diverge from and teach away from the invention at hand.", citing *In re Kuderna*, 165 USPQ 575 (CCPA 1970). Prior art references must be considered in their entirety in an obviousness inquiry and must include a "full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *American Standard, Inc. v. Pfizer, Inc.*, 14 USPQ 2d 1673, 1706 (D.C.Del. 1989). Although each reference used in an obviousness inquiry does not have to be enabling, disclosures in the references

that "teach away" from the claimed invention cannot be disregarded.
American Standard, Inc., 14 USPQ 2d at 1707, citing *W.L. Gore*.

A prior art reference may be considered to teach away when:

"a person of ordinary skill upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant."

Monarch Knitting Machinery Corp. V. Sulzer Morat, GmbH, 45 USPQ 2d 1977, 1984, citing *In re Gurley*, 31 USPQ 2d 1130, 1131 (Fed. Cir. 1994). There is no suggestion to combine, however, if a reference teaches away from its combination with another source. *Tec Air, Inc. v. Denso Manufacturing Michigan, Inc.*, 52 USPQ 2d 1294, 1298 (Fed. Cir. 1999), also citing *In re Gurley*.

In rejecting Claims 8, 13 and 14, the Examiner attempts to combine together a first patent (D'Antonio et al.) that teaches a diffusor with an internal chamber permitting absorption and a connection therebetween with another patent (Fries) that teaches a panel having a grooved front surface connected to a rear surface via a plurality of holes and wherein the only teaching whatsoever concerns absorption. The only place where the Examiner can go for the suggestion of how to assemble these two patents together to arrive at the claimed invention is through review of Applicants' own disclosure. Using Applicants' own disclosure as a blueprint to assemble together picked and chosen features from separate prior art references is improper, and a ground of rejection based upon

that manner of assembly of the prior art is improper and must be withdrawn. *Heidelberger Druckmaschinenag.* In so rejecting Claims 8, 13 and 14, the Examiner has used Applicants' patent application as an instruction book on how to reconstruct the prior art. Such a ground of rejection is improper. *Panduit Corp.*

Finally, the ground of rejection teaches away from the present invention. One of ordinary skill in the art looking at the D'Antonio et al. Patent would read disclosure of a diffuser incorporated into a cinder block having an internal chamber to provide absorption. Cinder blocks are structures used to assemble buildings and are assembled together using mortar to provide a seal so that a wall can be created that is impervious to moisture and vermin. One of ordinary skill in the art would never think to provide a cinder block with a physical connection, through the cinder block, between its front and rear surfaces, because such a connection would render the cinder block pervious. Thus, it is improper to modify D'Antonio et al. to make the cinder blocks thereof pervious in view of Fries. *W.L. Gore & Associates, Inc.* References that teach away from the claimed invention cannot be disregarded. *American Standard, Inc.* There is no suggestion to combine if a reference teaches away from its combination with another reference. *Tec Air, Inc.*

For these reasons, it is respectfully submitted that Claims 8, 13 and 14 patentably distinguish from the combination of D'Antonio

et al. and Fries, and for the same reasons, independent Claim 1 as now amended and all claims dependent therefrom patentably distinguish from the combination of D'Antonio et al. and Fries.

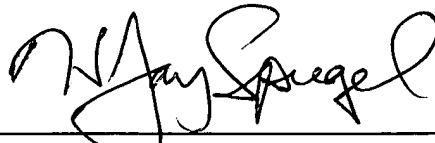
For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. As such, reconsideration and allowance of this application are respectfully submitted.

If, for any reason, the Examiner believes that an interview with Applicants' Attorney would be helpful in expediting the prosecution of this patent application, the Examiner is respectfully requested to telephone Applicants' Attorney locally at (703) 619-0101 so that a discussion of any outstanding issues may be had.

Again, reconsideration and allowance of this application are respectfully solicited.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read "H. Jay Spiegel", written over a horizontal line.

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